

### **Remarks**

An interview between the undersigned attorney and the Examiner was conducted by telephone on December 4, 2006. The Applicant thanks the Examiner for the courtesy of that interview.

According to the Examiner, an UNOFFICIAL pre-interview proposed amendment was mistakenly entered as a response to the second office action. The Applicants respectfully request that that UNOFFICIAL pre-interview proposed amendment be purged from the record and replaced by this official response.

The Office Action rejected all claims as allegedly being either anticipated by U.S. Patent 5,801,747 ("Bedard") or obvious over Bedard in view of either U.S. Patent 5,819,156 ("Belmont") or U.S. Patent 6,177,931 ("Alexander").

The Applicant herein cancels claims 43-51 and 65-76, amends claims 1, 6, 9, 13, 18, 21, 26, 31, 36, and 52 and adds new claims 79-98. The independent claims now pending are 1, 9, 13, 21, 25, 26, 31, 35, 36, 52, 61, 90, 97, and 98.

The Applicants believe that all claims are allowable and that the rejections should be withdrawn for at least the following reasons.

### **Bedard**

Bedard discloses a system that monitors television viewing activity to determine preferred channels and categories of programming for various viewers and then configures the display of an electronic program guide (EPG) in accordance with a viewer's favorites. More specifically, Bedard's system provides a "viewer profile" for each viewer, which is based on the viewer's actual viewing behavior, as illustrated for example in Figure 1. Bedard's system builds a viewer profile array 200, as illustrated in Figure 2, which appears to be a table-like data structure in which viewing behavior is stored by channels and programming categories in terms of "viewing units." Bedard's system tracks viewing behavior

by counting the discrete number of viewing units to approximately measure the time a channel is watched. Bedard states that the viewing unit can be “1 minute, 5 minutes, 10 minutes, etc.” or “fifteen minutes in duration.” (Col. 4, lines 9-12) If a viewer views a channel for less than this viewing unit, Bedard ignores that viewing activity. If, for example, the viewing unit is 5 minutes and a viewer views the same channel contiguously (without changing channels) for the entire duration of a one-hour program, then Bedard counts that as 12 viewing units on that channel. If the viewer watched the same channel in 12 different six-continuous-minute bursts over several days, Bedard would also count that as 12 viewing units of activity. This is apparent from Figure 3, which shows how Bedard’s system monitors and counts viewing activity.

Once Bedard’s system has accumulated viewing activity data for a viewer and stored that data in the viewer profile array 200, Bedard uses that data to influence how an EPG is displayed for that viewer. In particular, Bedard discloses that the viewer’s favorite channels (as measured by the raw number of viewing units) will be displayed at the top of the EPG, as explained at column 7, lines 39-41 and as shown in Figure 5. Bedard also discloses that the EPG may automatically surf through only the viewer’s favorite channels or only channels presently showing programs in the viewer’s favorite categories of programming. (Col. 7, lines 41-45).

Bedard also discloses a few other features, such as locking out viewing if the number of viewing units for a given category have reached a limit over a given period of time (e.g., block viewing sports after four hours in a week) (col. 7, line 65 – col. 8, line 15); providing the information stored in the viewer profile array 200 to broadcasters so that they can better target programming or advertising (col. 8, lines 16-21); and suggesting other, unviewed channels or websites that provide similar content (col. 8, line 22 – col. 9, lines 3).

#### Independent Claims 1, 13, and 26

Claim 1 is amended herein to read as follows:

1. A method for generating a list of channel favorites in an interactive television system, comprising:
  - receiving a first notification, the first notification indicating a first channel activity;
  - receiving a second notification, the second notification indicating a second channel activity;
  - calculating a time difference between the first and the second notifications; and
  - updating a channel favorites table based on the calculated time difference, wherein the favorites tables includes a field that signifies a preference for a way in which the channel favorites are displayed.

A “wherein” clause similar to the one at the end of this claim has also been added to independent claims 13 and 26 by amendment. Support for the “wherein” clause is found in the specification at, for example, page 20, lines 4-7; page 24, line 23 – page 25, line 7; page 32, line 22 – page 33, line 2; items 402 and 442 in Figures 4A and 4B; step 640 in the Figure 6 flowchart; and steps 1220 and 1230 in the Figure 12 flowchart. According to some of the illustrative examples discussed in the specification, a display preference 402 or 442 (Figures 4A and 4B) indicate whether the viewer’s favorite channels can be ordered by in numerical order by channel number, cumulative time watched, or number of times watched, for example. New dependent claims 79-87 recite some of these and similar possibilities specifically.

Claim 1 (along with other independent claims 13 and 26) was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Bedard. However, as the Examiner acknowledged during the interview, Bedard’s viewer profile array 200 contains **no** “field that signifies a preference for a way in which the channel favorites are displayed.” The viewer profile array simply contains channel entries 202, categories 208, and viewing unit counters 204 and 206. Notably absent from Figure 2 is any field that would indicate a preference as to a way to display the favorite channels. That is not surprising, given the fact that the **only** way in which Bedard’s system measures a viewer’s preference is by counting viewing units. Thus, Bedard’s system displays a viewer’s favorite channels in an order based on the number of viewing units logged on the channels in a table-style EPG, as explained in column 7, lines 8-27, or in an overlay EPG, as shown in Figure 5.

The Applicant therefore submits that the rejection of claims 1, 13, 26, and their dependents should be withdrawn, and those claims allowed.

Independent Claims 9, 21, and 31

Claim 9, as amended herein, reads as follows:

9. A method for generating a list of channel favorites in an interactive television system, comprising:  
receiving a first notification, the first notification indicating a first channel activity;  
receiving a second notification, the second notification indicating a second channel activity;  
calculating a time difference between the first and the second notifications; and  
updating a channel favorites table based on the calculated time difference, wherein the updating is performed if and only if the calculated time difference is larger than a threshold, wherein the threshold is ten seconds.

Independent Claims 21 and 31 contain similar “wherein” clauses as the last two “wherein” clauses in this claim.

Claims 9, 21, and 31 now stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Bedard. In reading the claim – before the present amendment – on Bedard, the Office apparently was interpreting the claim to read on any threshold larger than about ten seconds. Thus, the latest Office action contends that Bedard’s 1-minute, 5-minute, 10-minute, or 15-minute thresholds satisfy this limitation. However, the current amendment makes clear that the threshold is “ten seconds” and not something substantially greater as Bedard discloses. Bedard discloses no “viewing unit” less than one minute, as the Examiner acknowledged during the interview. (See, e.g., col. 3, line 63 – col. 4, line 14)

For all of the foregoing reasons, the Applicant requests that the § 102(b) rejection of claims 9, 21, and 31 be withdrawn, and that those claims and their dependents be allowed.

### Independent Claims 25, 35, and 61

Claims 25, 35, and 61 are written in means-plus-function form and must be interpreted according to the statutory mandate of 35 U.S.C. § 112, ¶ 6. That is what the United States Court of Appeals for the Federal Circuit has commanded the Office to do, *In re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994), and that is what Office policy requires, MPEP § 2182. That means that a rejection of a claim requires for each means-plus-function limitation that the Office make two showings: (1) that the reference disclose the identical function recited in the means-plus-function limitation and (2) that the reference's structure for performing that function be either the same as or equivalent to the corresponding structures in the specification.

The Office so far has not conducted step two of this required two-step analysis. In fact, the latest Office action is so bold as to assert that the second step is not required because equivalence of structure can be presumed when there is a showing of identical functions. The latest Office action cites no authority for that proposition. There is none. That is not the law.

During the interview, the Examiner requested that the Applicant identify the corresponding structure for each means-plus-function limitation. That correspondence is clearly set forth in the specification, and the Applicant kindly refers the Office to the specification. The Applicant is unaware of any authority that places an additional burden on applicants to do more, when the Office has not yet even attempted to perform a structural comparison of the claim limitations' against the references. Case law and the MPEP requires that the Examiner perform this analysis – or at least attempt to do so initially. Section 2183 of the MPEP clearly places this burden on the Office: “[T]he examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent.” Section 2183 then goes on enumerate four factors (A) – (D) by which structural equivalence can be shown. Only after structural equivalence has been shown in one of these ways does the burden shift to the Applicant to show non-equivalence.

Section 2182 of the MPEP also makes it crystal clear that “an Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification” (emphasis in original).

The Applicant therefore once again requests that the Office perform booth required steps to satisfy its initial burden to show unpatentability or allow the claims.

#### Independent Claims 36 and 52

Claim 36 as amended now reads as follows (with emphasis added):

**36.** An apparatus for creating favorite channels in an interactive television system, comprising:

a processor;

a generation engine executable by the processor and capable to generate a list including at least one favorite channel based upon a selection of a channel; and

a display engine executable by the processor and capable to enable the display of the list, wherein the list includes a plurality of channels listed based upon the numbers of times the respective channels has been watched, wherein a contiguous period of time watching a program is counted as one time regardless of the length of the period.

Independent claims 52 also contains similar “wherein” clauses as the last two “wherein” clauses in this claim. Support for this can be found, for example, in the paragraph at lines 1-14 of page 24 of the specification, which describes an illustrative embodiment as follows:

Updating the table 400 can include storing one or more of the channel name, channel number, time the channel was viewed, and incrementing a counter indicating the number of times the channel was viewed. Alternatively, if the channel is already in the favorites table 400, then the table 400 is updated by adding the amount of time the channel was viewed to the cumulative time for that channel and incrementing the frequency counter for that channel by one. In one embodiment, the generation engine 355 performs the updating (560). **For example, if a viewer watched CBS for 20 minutes, then, in table 400 of tables 365b (FIGURE 4b), cumulative time 413 for CBS (411) would be updated to 90:41 and frequency counter 414 for CBS (411) would be updated to 701.**

Channel Favorites Table

Table 400	Table 440
James (401)	Bill (441)
Numeric (402)	Time (442)
ABC (403)	ABC (443)
2 (404)	2 (444)
20:43 (405)	1:21 (445)
40 (406)	2 (446)
NBC (407)	CBS (447)
4 (408)	7 (448)
2:43 (409)	20:10 (449)
2 (410)	38 (450)
CBS (411)	MTV (451)
7 (412)	43 (452)
90:21 (413)	50:21 (453)
700 (414) ←	60 (454)
CNN (415)	
53 (416)	
20:21 (417)	
500 (418)	

FIG. 4B

365b

Claims 36 and 52 stand rejected as allegedly being anticipated by Bedard. According to the last Office action, Bedard's counters 204 or 206 in terms of viewing units are "numbers of times the respective channels has been watched." However, Bedard's viewing unit counters are not such that "a contiguous period of time watching a program is counted as one time regardless of the length of the period," as recited in the claim. A quick example makes this clear. If Bedard's viewing unit is 15 minute (a value Bedard prefers) and a viewer views the same channel contiguously (without changing channels) for the entire duration of a one-hour program, then Bedard counts that as **4** viewing units on that channel, whereas an apparatus according to claim 36 would count that as **one** single time the channel was watched. Thus, Bedard's system cannot distinguish between watching the same channel for 60 minutes continuously without interruption and watching that channel four different times for fifteen minutes each.

In light of the foregoing, the Applicant believes that the rejection of claims 36, 52, and their dependents should be withdrawn and that those claims are in condition for allowance.

### New Claims 90-98

New claims 90-98 are added herein, of which claims 90, 97, and 98 are independent. Claim 98, for example, refers to “a channel favorites table capable to store channel favorites of a viewer, wherein the channel favorites table is further capable to store cumulative times channels have been watched and to store counters indicative of the number of times said channels have been watched.” As the Examiner pointed out during the interview, Bedard’s channel favorites table (i.e., the view profile array 200) does not store both cumulative times channels have been watched and counters indicative of the number of times said channels have been watched. Instead, as noted above, Bedard stores “viewing units” counters in his view profile array 200, and a count of viewing units is not necessarily the same as a count of the number of times a channel has been watched. Claims 90 and 97 contain similar limitations and are patentable over Bedard for the same or similar reasons.



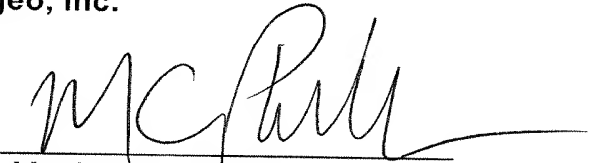
Conclusion

The Applicant believes that all claims are in condition for allowance and respectfully requests issuance of a Notice of Allowance. The Examiner is invited to call the undersigned attorney if any issues remain.

Respectfully submitted,

**Digeo, Inc.**

By

A handwritten signature in black ink, appearing to read 'MC Phillips', written over a horizontal line.

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